

The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY B. PEARSON and J. BRADLEY BRIDGES

Appeal 2007-1712
Application 10/696,395¹
Technology Center 2600

Decided: August 31, 2007

Before: JEAN R. HOMERE, JAY P. LUCAS, and MARC S. HOFF,
Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-10, 20-24, 26-29, and 31-42. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ Application filed October 29, 2003. The real party in interest is SBC Knowledge Ventures, L.P.

Appellants' invention relates to a video distribution system that decodes an incoming video information stream and modulates chosen content onto one or more frequency bands or channels to which a user may tune from any television in the user's house. The channels may be set to correspond to individual users, and access to content on a particular user's channel may be subject to authentication that the requesting user is authorized to view that channel.

Claim 1 is exemplary:

1. A video distribution system comprising:

a receiver operable to receive a multiplexed signal comprising a plurality of encoded video information streams;

a first decoder communicatively coupled to the receiver and operable to decode a first video information stream of the multiplexed signal;

a second decoder communicatively coupled to the receiver and operable to decode a second video information stream of the multiplexed signal;

a combiner operable to output a composite signal from communication via a premise network, the composite signal comprising a decoded first video information stream modulated to a first radio frequency band associated with a first user and a decoded second video information stream modulated to a second radio frequency band associated with a second user;

a remote control mechanism operable to communicate a request signal to the first decoder requesting that the first decoder decode a different video information stream of the multiplexed signal; and

an access engine to authenticate that a user of the remote control mechanism is associated with the first radio frequency band.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Reyes	US 2002/0078442 A1	Jun. 20, 2002
Eames	US 6,493,875 B1	Dec. 10, 2002
Milovanovic	US 2003/0028872 A1	Feb. 6, 2003
Kolde	US 6,762,773 B2	Jul. 13, 2004
Horiwitz	US 6,785,901 B1	Aug. 31, 2004
Ellis	US 2005/0251827 A1	Nov. 10, 2005
Sheppard	US 6,978,474 B1	Dec. 20, 2005

Claims 1, 2, 4, 6-10, 20, 22, 24, 26-28, 34, 36 and 40 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sheppard in view of Ellis. Claims 3, 5, 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sheppard in view of Ellis and Kolde. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being obvious over Sheppard in view of Ellis and Appellants' admission of fact (APA). Claims 29, 31-33, 39 and 41 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sheppard in view of Ellis and Reyes. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being obvious over Sheppard in view of Ellis and Eames. Claim 35 stands rejected under 35 U.S.C. § 103(a) as being obvious over Sheppard in view of Ellis and Milovanovic. Claim 42 stands rejected under 35 U.S.C. § 103(a) as being obvious over Sheppard in view of Ellis, Reyes and Horiwitz.

Appellants contend that the Examiner erred because neither Sheppard nor Ellis teaches associating a video information stream, modulated on a particular radio frequency band, with a particular user of the video distribution system. The Examiner contends that Sheppard teaches

associating a television with a carrier frequency, and that Ellis teaches associating a television with a user; therefore, the asserted combination teaches associating a carrier frequency with a particular user.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

*See 37 C.F.R. § 41.37(c)(1)(vii) (2004).*²

ISSUE

The principal issue in the appeal before us is whether the Examiner erred in stating that Sheppard in combination with Ellis meets the claim limitation of a decoded first video information stream modulated to a first radio frequency band (or carrier frequency) associated with a first user, and a decoded second video information stream modulated to a second radio frequency band (or carrier frequency) associated with a second user.

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. Appellants invented a video distribution system that receives a multiplexed signal representing several different video information streams, decodes a desired stream or streams, and modulates them onto radio frequency bands associated with particular individual users (Specification 4:2-12, 5:23-6:18).

2. One of the purposes of Appellants' invention is to obviate the need for a set top box located at each television in the user's house (Specification 2:14-21).

3. Each individual user selects the television programming that is to be modulated to the channel associated with that user (for example, "Dad's channel" is channel 7, and "Mom's channel" is channel 8). The user may then view "his" programming on any television in the house, simply by tuning to "his" channel (Specification 7:19-28).

4. Appellants' invention provides the ability to send and display messages addressed to an individual user (Specification 8:1-5).

5. Appellants' invention provides the ability to authenticate the identity of a user desiring to watch a particular channel, such that only the authorized user may view the television content being modulated to that channel (Specification 11:13-22).

Sheppard

6. Sheppard teaches a residential gateway (RG) for distributing video, data and telephone services to multiple devices within a reference (col. 1, ll. 57-67).

7. The residential gateway includes MPEG modules that decompress incoming video signals and modulate the decompressed analog format video signal onto an available television channel for transmission to remotely located televisions (col. 10, ll. 49-58).

8. The remotely located televisions would be set to a particular channel, for example channel 3 or 4 just like a VCR, and the channel selection for the remotely located televisions would then be controlled by a wireless remote control associated with each remotely located television, the channel select commands being transmitted directly to a wireless receiver within the residential gateway (col. 10, ll. 27-34).

Ellis

9. Ellis teaches a video distribution system in which each television in a house is equipped with a set-top box, which receives program guide data, and which transmits information such as pay-per-view program orders to the information provider (para. [0064]).

10. The user may select one television in the house as the “master,” on which that user may control settings (such as parental access controls) for all other televisions in the house. The user interface assigns locations to the other television in the house, for ease of identification of one set as the master (para. [0089]-[0091]).

11. For example, the television in the “parents’ room” may be designated as the master location, and another television in the “children’s room” may be designated as a ‘slave’ location (para. [0092]).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (*citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner’s conclusion.

The determination of obviousness must consider, *inter alia*, whether a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124, 56 USPQ2d 1456, 1458-59 (Fed. Cir. 2000). *Medichem S.A. v. Rolabo S.L.*, 437 F.3d 1157, 1164, 77, USPQ2d 1865, 1869 (Fed. Cir. 2006). Where the teachings of two or more prior art references conflict, the examiner must weigh the

power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

ANALYSIS

Appellants argue that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a), because neither Sheppard nor Ellis meet the claim limitation of “a decoded first video information stream modulated to a first radio frequency band associated with a first user and a decoded second video information stream modulated to a second radio frequency band associated with a second user,” as recited in claim 1; or “a plurality of remote controllable channel output modules, each configured to output a signal modulated to an assigned frequency block associated with a particular user,” as recited in claim 20; or “linking a plurality of users with associated carrier frequencies,” then “modulating a decoded video stream … on the first carrier frequency” [which is associated with the first user], as recited in claim 29 (and almost identically in claim 40).

The Examiner admits that Sheppard does not teach the claimed association between user(s) and frequency band(s), but asserts that Ellis teaches a video distribution system wherein a plurality of users are associated with a plurality of televisions, and the users may configure settings associated with an interactive program guide (Answer

5:3-8). Because Sheppard teaches associating a television with a carrier frequency and Ellis teaches associating a television with a user, the Examiner reasons, the combination of Sheppard and Ellis therefore teaches associating a carrier frequency with a particular user (Answer 23:5-17).

In response, Appellants argue that Ellis discloses an interface that associates each set-top box device with a particular location (living room, guest room, children's room), irrespective of the user or users who may actually be watching a television at each location (Reply Br. 2:20-23; FF 10). Thus, according to Appellants, Ellis does not teach an association between television and user, but merely between television and room, and the asserted combination fails to teach every claim limitation.

Appellants further argue that the Examiner's interpretation of "association" is unreasonably expansive. The Examiner argued that a particular user watching a particular television is 'associated with' ... a particular television. A particular television being watched is 'associated with' ... a particular frequency/channel. Therefore, in light of the specification, a particular user is reasonably construed as being associated with or having some relationship to a particular 'channel' by virtue of watching a particular television. Answer 22: 3-13.

We agree with Appellants that the combination of Sheppard and Ellis does not meet the claim limitations. The Examiner directs Appellants to paragraphs [0064] and [0089]-[0092] of Ellis as allegedly teaching that Ellis associates a plurality of users within a household with a plurality of televisions. Paragraph [0064] merely discloses that each item of user television equipment 44 has a set-top box 48, which periodically receives program guide data, and which may also periodically provide information concerning pay-per-view programs ordered (FF 9). Paragraphs [0089] to

[0092] disclose that a user may select one television to be the “master,” on which a user may control settings (such as parental controls) for all other devices in the household. The user interface assigns locations to the various televisions in the house such that one television may conveniently be designated as the master (FF 10, 11). The Examiner states that Ellis associates one television with an adult or parent, and associates another with a child (Answer 5:10-11), but Ellis discloses only that the television in the “parents’ room” may be designated as the master location, and another television in the “children’s room” may designated as a ‘slave’ location (FF 11). We find that Ellis does not teach an association between a particular user and a particular television, because nothing in Ellis precludes a child from watching the television in the parents’ room, nor a parent in the child’s room.

We further agree with Appellants that the Examiner’s interpretation of the term “associated,” when read in light of Appellants’ Specification, is not reasonable. One of the purposes of Appellants’ invention is to provide the ability to view multiple different television programs on the different televisions in a house, while eliminating the need for a set-top box for every television, by providing a system in which the frequency band corresponding to a standard over-the-air channel is assigned to a particular person, e.g. “Dad’s channel” is channel 7, “Mom’s” is channel 8, etc. (FF 2, 3). Appellants’ system may send messages addressed to a particular user, and also provides the ability to authenticate a user desiring to watch, e.g., Dad’s channel, so that unauthorized users are not provided access to the programming being modulated to that channel (for example, to implement

parental control of content) (FF 4, 5). With those purposes in mind, we find that it is not a reasonable interpretation of “association” to say that anyone watching a television is necessarily “associated” with that television, because Appellants contemplate the ability to send messages meant specifically for Dad, and to restrict users other than Dad from watching Dad’s channel. As a result of so finding, we find that neither reference teaches modulating (at least) first and second video information streams to respective first and second radio frequency bands respectively *associated* with particular users of a video distribution system.

Because Appellants have shown that the Examiner’s proposed combination of references is impermissible, we will not sustain the Examiner’s rejection of claims 1-10, 20-24, 26-29 and 31-42 under 35 U.S.C. § 103(a). Since no independent claim rejection is affirmed, we need not reach Appellants’ arguments concerning the dependent claims.

CONCLUSION OF LAW

We conclude that Appellants have shown the Examiner erred in rejecting claims 1-10, 20-24, 26-29 and 31-42. On the record before us, Claims 1-10, 20-24, 26-29 and 31-42 have not been shown to be unpatentable.

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DECISION

The Examiner's rejection of claims 1-10, 20-24, 26-29 and 31-42 is reversed.

REVERSED

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